



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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	EXAMINER
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ART UNIT	PAPER NUMBER
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DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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1. Receipt is acknowledged of the election filed January 12, 2001.
2. Claims 4-6, 8-9, 12-14, 22, 24-26, 29, 32, 36, 38-40 and 54-72 are pending in the instant application.

Claims 2-3, 7, 10-11, 15-21, 23, 27-28, 30-31, 33-35, 37 and 41-53 have been cancelled.

Claim 1 was previously cancelled.

3. Applicant had previously elected with traverse, Invention II, Claim 22 and dependent claims drawn to a method of producing a composition of extracts of plant material, classified in class 424, subclass 195.1.

Applicant was not in full compliance with the election requirement for the species election in accordance with the requirement to list all claims readable on the elected invention. Applicant was not in full compliance with the requirement to fully support each and every additional claim, see MPEP: 714:

The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP § 2163.06.

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It will be considered that based on the previous Office action whereby Claims 22, 29, 36, 38-39 and 40 were drawn to the elected invention. Claims 24-26 and 32 are drawn to the non-elected species.

In accordance with the election species, as noted on Page 3 of Paper No. 8 dated July 24, 2000, Applicant had elected one extract of a plant material.

Therefore, only **Claims 22, 29, 36 and 38- 40 will be considered to read on the elected Invention drawn to the elected species.**

4. The rejection of the claims under 35 U.S.C. 102 and 35 U.S.C. 103 as noted by paragraph of Office action dated August 10, 2000 over Ageel et al BIOS ABSTRACT BA89:92285, Kavimani et al CABA ABSTRACT 2000:53058 or Shah et al SCISEARCH ABSTRACT 91:548657 have been withdrawn in view of the amendment to the claims.

5. Applicant was not in compliance with PTO Rules in amending Claims, see

§ 1.121 Manner of making amendments.

(a) Amendments in nonprovisional applications, other than reissue applications : Amendments in nonprovisional applications, excluding reissue applications, are made by filing a paper, in compliance with 1.52, directing that specified amendments be made. (1) Specification other than the claims. Except as provided in 1.125, amendments to add matter to, or delete matter from, the specification, other than to the claims, may only be made as follows: (i) Instructions for insertions: The precise point in the specification must be indicated where an insertion is to be made, and the matter to be inserted must be set forth. (ii) Instructions for deletions: The precise point in the specification must be indicated where a

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deletion is to be made, and the matter to be deleted must be set forth or otherwise indicated.(iii) Matter deleted by amendment can be reinstated only by a subsequent amendment presenting the previously deleted matter as a new insertion. (2) Claims . Amendments to the claims may only be made as follows: (i) Instructions for insertions and deletions: A claim may be amended by specifying only the exact matter to be deleted or inserted by an amendment and the precise point where the deletion or insertion is to be made, where the changes are limited to: (A) Deletions and/or (B) The addition of no more than five (5) words in any one claim; or (ii) Claim cancellation or rewriting: A claim may be amended by directions to cancel the claim or by rewriting such claim with underlining below the matter added and brackets around the matter deleted. The rewriting of a claim in this form will be construed as directing the deletion of the previous version of that claim. If a previously rewritten claim is again rewritten, underlining and bracketing will be applied relative to the previous version of the claim, with the parenthetical expression twice amended, three times amended, etc., following the original claim number. The original claim number followed by that parenthetical expression must be used for the rewritten claim. No interlineations or deletions of any prior amendment may appear in the currently submitted version of the claim. A claim canceled by amendment (not deleted and rewritten) can be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number.

At least Claim 22, was improperly amended, since original Claim 22 added in the preliminary amendment is clearly not of the same scope or amended correctly. It is also noted that the Claim was noted as (twice amended) but it appears that the first amended Claim 22 is not on record.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claim 22, 29, 36 and 38-40 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant has amended broadened the claims to read on any solvent whereas the original claims were limited to organic solvents. A search and examination was based only on organic solvents. Applicant has already received an Office action based on the claimed limitation. In addition, the specification does not apparently support the broader claimed subject matter. As noted in the restriction requirement of Paper No. 6, Applicant was requested to fully support the claimed limitations for all of the amended claims. Applicant did not respond to this requirement in the response to the election requirement. Applicant had amended the claims after the first Office action on the merits and again Applicant did not specifically point out the support for any amendments made to the disclosure. See MPEP § 2163.06. The removal of the limitation “organic” clearly opens the claimed subject matter which was not searched nor examined. This is considered to be new matter since it appears that the amended claim is not supported by the original specification.

Newly submitted claims directed to an invention that is independent or distinct from the invention originally claimed which was limited to the organic solvent. Since applicant has received an action on the merits for the originally presented invention,

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this invention has been constructively elected by original presentation for prosecution on the merits even if Applicant has support for the broad claimed invention.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 22, 29, 36 and 38- 40 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Suffness et al NAPRALERT 92:92342 (Reference W) or Kokwaro NAPRALERT 92:32733 (Reference X)

Each of the references teaches an organic polar solvent extract of *Hagenia Abyssinica* which anticipates the claimed inventions or render the claims obvious for the separation of the extract absent a showing of unexpected or unobvious process steps.

7. **No Claim is allowed.**

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8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lilling whose telephone number is (703) 308-2034 and fax number (Art Unit 1651) is (703) 305-7939 or SPE Michael Wityshyn whose telephone number is (703) 308-4743. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

H.J.Lilling: HJL
(703) 308-2034
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March 13, 2001